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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,306	09/30/2003	Jorge F. Escobar	HSJ920030204US1	5363

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EXAMINER	
SNIEZEK, ANDREW L	
ART UNIT	**PAPER NUMBER**
2651	

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/675,306	ESCOBAR ET AL.	
	Examiner	Art Unit	
	Andrew L. Sniezek	2651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *1/23/04*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *30 September 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17,2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *1/23/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 1/23/04 has been considered.

Drawings

2. The drawings filed 9/30/03 are acceptable to the examiner.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 17-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 17-20 set forth a computer program product of claim 15, however claim 15 is directed to rapidly warming a hard disk drive and has nothing to do with a computer program product and therefore these claims do not further limit the method of claim 15. Exactly what aspect of a computer program product that is being limited can not be determined from these claims.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 16-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 16-20 are drawn to a "program" *per se* as recited in the preamble and as such is non-statutory subject matter. See MPEP § 2106.IV.B.1.a. Data structures not claimed as embodied in computer readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention, which permit the data structure's functionality to be realized. In contrast, a claimed computer readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory. Similarly, computer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and

functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized. The term "residing" claim 16, line 1 is not considered have the same meaning as "embodied".

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5-10, 12-17 and 19-20 of U.S. Patent No. 6,934107. Although the conflicting claims are not identical, they are not patentably distinct from each other because each is directed to changing the mode of operation of a drive based a temperature of the drive. Any differences in the claims are deemed to be an obvious wording of the claimed invention in which one of ordinary skill could have made.

8. Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,865,506. Although the conflicting claims are not identical, they are not patentably distinct from each other because each is directed to changing the mode of operation of a drive based a temperature of the drive. Any differences in the claims are deemed to be an obvious wording of the claimed invention in which one of ordinary skill could have made.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 1, 4-6, 9-11, 14-16, 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ottesen et al.

Re claims 1 and 4: Ottesen et al. teaches a disk drive arrangement and corresponding method of operation in which a temperature of the drive is monitored in relation to a desired temperature (threshold) column 6, lines 50-64 and controls a disk spindle speed to cool the drive if the threshold temperature is exceeded. Claim 1 additionally sets forth that the controlling method occurs during testing of the disk drive and that switching between the modes occurs based on the temperature. The testing feature is satisfied by the arrangement of Ottesen et al. at least by the temperature testing arrangement as disclosed. The claimed switching back between the modes although not specifically discussed in Ottesen et al., such a feature would have been obvious to one of ordinary skill in the art at the time of the invention given the teaching of Ottesen et al. since there would be no need to maintain a slow speed of operation if the disk drive is below a given temperature and therefore would have been obvious to increase the speed of rotation to allow for an increase in recording/reproducing speed. Also, note claim 3 which discusses plural velocities. Claims 6, 9, 11, 14, 16, 19 although written using different language this language is deemed to amount to the same as that previously set forth in claims 1 and 4 and therefore rejected for similar reasons. Additionally the claimed program code as set forth in claims 16 and 19 are deemed satisfied by the program code in which CPU (2110 uses to control the operation of the drive. The claimed clock speed as set forth in claims 5, 10, 15 and 20 are deemed satisfied by the arrangement of figure 2 that includes a motor control (210, 205 and 202) that is used to provide appropriate signals to control speed of rotation of the spindle.

12. Claims, 2-3, 7-8, 12-13 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ottesen et al. in view of Francis et al.

The teaching of Ottesen et al. is discussed above and incorporated herein. Claims 2-3, 7-8, 12-13 and 17-18 additionally set forth to change the seek modes based on the temperature. Although this feature is not taught by Ottesen et al. such is well known as taught by Francis et al. (see for example abstract) to maintain a temperature within a safe level. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporated the teaching of Francis et al. in the arrangement of Ottesen et al. such that while monitoring a temperature in a seek speeds are changed to maintain a safe temperature range of the drive.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US006169930B1, US006747838B2, US006078455A , US 20030227706A1, US 20030048571A1 are cited showing related arrangements.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew L. Sniezek whose telephone number is 571-272-7563. The examiner can normally be reached on Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Hudspeth can be reached on 571-272-7843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Andrew L. Sniezek
Primary Examiner
Art Unit 2651

A.L.S.
10/1/05